

Remarks

Further and favorable reconsideration is respectfully requested in view of the foregoing amendment and following remarks.

Initially, item 1 on page 2 of the Office Action indicates that claims 16-35 have been cancelled, and that claims 26-55 have been added. Perhaps this is a word processing error. As correctly noted on the Office Action Summary page, the pending claims are claims 1-22, of which claims 5-9 and 12-22 have been withdrawn from consideration. Thus, the only claims under consideration are claims 1-4, 10 and 11.

In response to the objection to claim 3 in item 6, this claim has been cancelled. Applicants note that the scope of claim 3 is the same as that of claim 1, which remains in the application.

The rejection of claims 1-4, 10 and 11 under the first paragraph of 35 U.S.C. §112, as failing to comply with the written description requirement, is respectfully traversed.

The Examiner takes the position that the expression “provided that R² and R³ are not simultaneously a hydrogen atom” constitutes a negative limitation, and is not supported by the specification as filed.

However, the specification does disclose that each of R² and R³ can be hydrogen (e.g. see page 2, line 15 of the specification), and in view of this positive disclosure that each of R² and R³ can be hydrogen, the possibility of both R² and R³ being simultaneously hydrogen may be explicitly excluded in the claims. In this regard, please see MPEP 2173.05(i), which states that:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described in the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. . . . Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

It is true that the expression “provided that R² and R³ are not simultaneously a hydrogen atom” is not literally set forth in the application as filed. But as indicated in the portion of MPEP 2173.05(i) quoted above, “a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.” The specification does disclose that each of R² and R³ can be hydrogen (page 2, line 15), and since this alternative is positively recited in the specification, it may be explicitly excluded in the claims, as also indicated in the MPEP section quoted above.

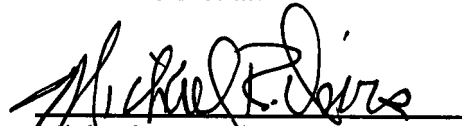
For these reasons, Applicants respectfully submit that the rejection of the claims under the first paragraph of 35 U.S.C. §112 should be withdrawn.

Therefore, in view of the foregoing amendment and remarks, it is submitted that each of the grounds of objection and rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

Shigeru YAMAGO et al.

By:



Michael R. Davis
Registration No. 25,134
Attorney for Applicants

MRD/pth
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
June 1, 2007